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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAX B. COWDEN, KEVIN V. DAHLSTROM,
SCOTT G. EAGLE, CHARLES GILBERT, PHILIP D. HOLLRAH,
ANTHONY G. MARTIN, JEFFREY A. MCFADDEN,
MARC E. SILVERBERG

Appeal 2007-2474
Application 09/993,904
Technology Center 2100

Decided: May 30, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 2, and 4-7. Claims 3 and 8 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). Appellants' attendance at the Oral Hearing set for May 22, 2008 was waived.

We REVERSE. We also enter new grounds of rejection against claims 1, 2, and 4-7 under the provisions of 37 C.F.R. § 41.50(b).

THE INVENTION

The disclosed invention relates generally to computer systems, and more particularly, to the detection and processing of windows (Spec. 1).

Independent claims 1 and 7 are illustrative:

1. A method of providing product information to a user, the method to be performed by computer-readable program code running in a computer, the method comprising:
 - detecting an occurrence of a first window in the computer;
 - determining if the first window includes an offer to download a computer program;
 - identifying the computer program; and
 - displaying a second window in the computer, the second window including third party information about the computer program.
7. A computer memory comprising:
 - a listener, the listener including computer-readable program code for detecting the opening of a new window;
 - a product list, the product list including a list of computer programs and a description of each of the computer programs, the description of each of the

computer programs comprising third-party information that helps users decide whether they should install a computer program being offered for download;

a window analyzer, the window analyzer including computer-readable program code for detecting whether the new window is offering a computer program listed in the product list for download;

a user interface manager, the user interface manager including computer-readable program code for displaying third party information about the computer program offered in the new window and listed in the product list.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the §103 rejection:

Fawcett	US 6,327,617 B1	Dec. 4, 2001
Slotznick	US 6,011,537	Jan. 4, 2000

THE REJECTIONS

Claims 1, 2, and 4-6 stand rejected under 35 U.S.C. §112, second paragraph.

Claims 1, 2, and 4-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fawcett in view of Slotznick.

PRINCIPLES OF LAW

Obviousness under 35 U.S.C. § 103

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v.*

Teleflex, Inc., 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

ISSUE(S)

We have determined that the following issues are dispositive in this appeal:

1. Whether claims 1, 2, and 4-6 are indefinite (incomplete) for omitting essential steps, such omission amounting to a gap between the steps.
2. Whether the language recited in the preamble of independent claim 1 precludes the steps of the method from being performed by a person.
3. Whether the primary Fawcett reference teaches or suggests “a window analyzer, the window analyzer including computer-readable program code for detecting whether the new window is offering a computer program

listed in the product list for download,” as recited within independent claim 7.

ANALYSIS

Issue 1

We consider the question of whether claims 1, 2, and 4-6 are indefinite (incomplete) for omitting essential steps, where such omission amounts to a gap between the steps.

The Examiner contends that these claims are indefinite as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. The Examiner notes that the preamble of the claim teaches the process of providing product information to a user, whereas the body of the claim teaches providing third-party information about the computer program. (Ans. 3). The Examiner contends that “[t]here is simply no correspondence between the process steps disclosed in the body of the claim.” (Ans. 4). In particular, the Examiner contends that “there is no suggestion in the claims of the process of analyzing the window in order to determine whether a window is good or bad.” (*Id.*).

Appellants counter that “[t]here is no inconsistency between the preamble and the body of claim 1. The preamble of claim 1 recites a method of providing product information, while the body of claim 1 recites providing third party information about a computer program. As is well known, a computer program may be a product.” (App. Br. 6).

After considering the evidence before us, we reverse the Examiner’s 112, second paragraph, rejection for essentially the same reasons argued by

Appellants in the Brief. We agree with Appellants' observation that a computer program may be a product. While the steps of the method of claim 1 may not recite every detail of Appellants' invention as disclosed in the Specification (as pointed out by the Examiner), we nevertheless conclude that the issue raised by the Examiner pertains to the breadth of the claim, rather than to any issue of indefiniteness arising from essential steps not being recited.

Issue 2

We consider the question of whether the language recited in the preamble of independent claim 1 precludes the steps of the method from being performed by a person.

From the record before us, it is clear that the Examiner's reading of the claim on the primary Fawcett reference depends upon certain steps in claim 1 being performed by a person, instead of by a computer executing a program.

For example, regarding the "determining" step of claim 1, the Examiner reads this step on Fawcett's teaching of a process for obtaining computer software from a remote computer wherein "[i]f a new version of existing computer software, or new computer software is available, the user is asked if she wishes to purchase the computer software." (Fawcett, col. 10, ll. 28-30) (*see* Ans. 11, ¶3).

The Examiner reasons that without a step of determining if the first window in Fawcett includes an offer to download the computer software, then "the users in Fawcett will not be able to purchase the software." (Ans. 11, ¶2). The Examiner grounds this reasoning on the premise that "the claim

fails to [specify] if the functionality of determining if the first window includes an offer to download the computer program is with respect to a *user* or a *program*.” (Ans. 11, ¶4, emphasis added). Thus, it is clear from the record before us that the Examiner reads the claimed step of “determining” on a mental determination performed by a user in Fawcett.

Claim Construction

After considering the record before us, we conclude that the Examiner has failed to consider the claim as a whole. We begin our analysis by noting that the preamble of claim 1 expressly requires the method to be performed by “computer-readable program code running in a computer,” as follows:

A method of providing product information to a user, the method to be performed by computer-readable program code running in *a computer*, the method comprising:
(claim 1) (emphasis added).

We note that the preamble includes a structure (i.e., “a computer”) that provides a positive antecedent basis for “the computer” recited in the “displaying” step that is part of the body of claim 1.

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801 (Fed. Cir. 1990). When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. *See Electro Sci. Indus. v. Dynamic Details, Inc.*, 307

F.3d 1343, 1348 (Fed. Cir. 2002); *Rapoport v. Dement*, 254 F.3d 1053, 1059 (Fed. Cir. 2001); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1306 (Fed. Cir. 1999).

This reasoning is applicable here. Therefore, we conclude that the scope of the claimed step of “determining if the first window includes an offer to download a computer program” is limited to embodiments where the determination is performed by “computer-readable program code running in a computer,” as expressly claimed (claim 1). Because we conclude that the scope of the claim does not encompass a human user performing a mental step of “determining” (as proffered by the Examiner), we find the Fawcett reference falls short of teaching or suggesting at least this limitation. Moreover, we find the secondary Slotznick reference fails to remedy the aforementioned deficiency of Fawcett.

Because we conclude that Appellants have met their burden of showing that the Examiner has failed to establish a prima facie case of obviousness, we reverse the Examiner’s rejection of independent claim 1 as being unpatentable over Fawcett in view of Slotznick. Because each dependent claim includes all the limitations of independent claim 1, we also reverse the Examiner’s rejections of dependent claims 2 and 4-6.

Issue 3

We consider the question of whether the primary Fawcett reference teaches or suggests “a window analyzer, the window analyzer including computer-readable program code for detecting whether the new window is

offering a computer program listed in the product list for download,” as recited within independent claim 7.

In the rejection, the Examiner relies upon the primary Fawcett reference as purportedly teaching this limitation at column 10, lines 25-43. (Ans. 7, ¶1, l. 5). However, our review of this portion of Fawcett clearly indicates that Fawcett “allow[s] a user to check for new versions of existing computer software, or new computer software available from the update service.” (Fawcett, col. 10, ll. 24-27). To the contrary, we conclude that the functional language of claim 7 is performed by computer-readable program code encoded in a computer memory, as required by the language of the claim. Therefore, we do not agree with the Examiner that Fawcett’s teaching of a human user doing the checking (i.e., detecting) fairly teaches or suggests “a window analyzer, the window analyzer including computer-readable program code for detecting whether the new window is offering a computer program listed in the product list for download,” as expressly recited within independent claim 7. We find the secondary Slotznick reference fails to remedy the aforementioned deficiency of Fawcett.

Moreover, the Examiner has failed to respond to any of Appellants’ arguments directed to independent claim 7, as noted by Appellants in the Reply Brief (Reply Br. 5). Therefore, we agree with Appellants that the Examiner has failed to establish a prima facie case of obviousness for independent claim 7. Accordingly, we reverse the Examiner’s rejection of claim 7 as being unpatentable over Fawcett in view of Slotznick.

NEW GROUNDS OF REJECTION

35 U.S.C. § 112, second paragraph

Using our authority under 37 C.F.R. § 41.50(b), we reject claims 1, 2, and 4-7 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We note that Appellants present a definition for the claim term “window” in the Specification, as follows:

In the present disclosure, the term "window" is used to refer to any mechanism for presenting information to a user. Thus, the term "window" also includes message boxes, dialog boxes, text boxes, banners, *etc.* A window may be associated with a web browser, or may be generated as a result of receiving information from another computer over a computer network or from a local computer program.
(Spec. p. 5, l. 19 through p. 6, l. 1) (emphasis added).

We particularly note the use of the broadening term “etc.” (*Lat. et cetera - and so forth*) to expand the scope of the claimed “window” to encompass an open set. Thus, as supported by Appellants’ Specification, the scope of the claimed “window” broadly encompasses all means, including future, unknown means, for presenting information. Therefore, we conclude that the instant claims have undue breadth and do not positively set forth that which Appellants’ regard as their invention. Accordingly, we conclude that claims 1, 2, and 4-7 are indefinite under 35 U.S.C. § 112, second paragraph. We note that our rationale here (undue breadth) is altogether different than the rationale applied by the Examiner under 35 U.S.C. § 112, as discussed *supra*.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude Appellants have met their burden of showing that the Examiner erred in rejecting claims 1, 2, and 4-6 under 35 U.S.C. §112, second paragraph.

Likewise, we conclude Appellants have met their burden of showing that the Examiner erred in rejecting claims 1, 2, and 4-7 under 35 U.S.C. § 103(a) for obviousness.

DECISION

We reverse the Examiner's decision rejecting claims 1, 2, and 4-7.

REVERSED
37 C.F.R. § 41.50(b)

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